

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATORU YUKIE and GINA C. EUBANKS

Appeal No. 2004-2250
Application No. 09/542,154¹

ON BRIEF

Before SAADAT, MACDONALD and NAPPI, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-16 and 27-31. Claims 17-26 have been canceled.

We affirm.

BACKGROUND

Appellants' invention relates to a user interface including a personalized toolbar with multiple icons, each associated with a source of digitized content which is in communication with the

¹ Application for patent filed April 4, 2000.

user terminal. According to Appellants, a user can configure the icons to cause data from any of the respective sources be displayed on a monitor (specification, page 4).

Representative independent claim 1 is reproduced as follows:

1. A graphical user interface (GUI) comprising:

a user terminal including a monitor;

a personalized toolbar presentable on the monitor and having plural icons, each icon being associated with a respective network address of a respective source of digitized content in point-to-point wireless communication with the terminal, whereby a user can configure an icon to cause data from the respective source to be presented on the monitor, wherein

at least a first source represents one of: a feed from a video camera located in a dwelling, a stock market feed with portions of its stock information compiled into customized user-defined portfolio, an electronic journal of a user's personal finances, and an intra-office or inter-office intercom associated with a user or with a small group of people to which the user belongs, at least a second source representing one of: a telephone, and an in-home appliance.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Oran et al. (Oran)	5,617,526	Apr. 1, 1997
Nielsen	5,813,007	Sep. 22, 1998
Brown	5,914,714	Jun. 22, 1999
Anderson et al. (Anderson)	5,917,488	Jun. 29, 1999
Namma et al. (Namma)	6,182,116	Jan. 30, 2001
		(filed Sep. 14, 1998)
Humpleman et al. (Humplemen)	6,288,716	Sep. 11, 2001
		(filed Jun. 24, 1998)
Shuping et al. (Shuping)	6,313,855	Nov. 6, 2001
		(filed Feb. 4, 2000)
Barnett et al. (Barnett)	6,369,840	Apr. 9, 2002

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(filed Mar. 10, 1999)

Gerba et al. (Gerba)	6,492,997	Dec. 10, 2002 (filed Jun. 24, 1998)
Kikinis	6,625,126	Sep. 23, 2003 (filed Jul. 12, 1999)

Claim 30 stands rejected under the second paragraph of
35 U.S.C. § 112 as being indefinite.

Claims 1, 2 and 30 stand rejected under 35 U.S.C. § 103 as
being unpatentable over Brown, Kikinis, Namma and Humpleman.

Claims 3 and 28 stand rejected under 35 U.S.C. § 103 as
being unpatentable over Brown, Kikinis, Namma, Humpleman and
further in view of Shuping.

Claim 4 stands rejected under 35 U.S.C. § 103 as being
unpatentable over Brown, Kikinis, Namma, Humpleman and further in
view of Barnett.

Claims 5-7, 10, 12-15, 27 and 31 stand rejected under 35
U.S.C. § 103 as being unpatentable over Brown, Kikinis, Namma,
Humpleman and further in view of Gerba.

Claims 8 and 16 stand rejected under 35 U.S.C. § 103 as
being unpatentable over Brown, Kikinis, Namma, Humpleman, Gerba
and further in view of Nielsen.

Claim 9 stands rejected under 35 U.S.C. § 103 as being
unpatentable over Brown, Kikinis, Namma, Humpleman, Gerba and
further in view of Anderson.

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Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Brown, Kikinis, Namma, Humpleman, Gerba and further in view of Barnett.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Brown, Kikinis, Namma, Humpleman, Gerba, Nielsen and further in view of Oran.

We make reference to the answer (Paper No. 20, mailed April 7, 2004) for the Examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 16, filed August 25, 2003), supplemental brief (Paper No. 19, filed January 28, 2004) and the reply brief (Paper No. 21, filed April 15, 2004) for Appellants' arguments thereagainst.

OPINION

With respect to the rejection of claim 30 under the second paragraph of 35 U.S.C. § 112, the Examiner identifies the terms "the method acts" and "the logic" as having insufficient antecedent basis (answer, page 3). In response, Appellant relies on MPEP § 2173.05(e) and argues that if the scope of the claim can be determine, lack of antecedent basis for these terms does not make the claim indefinite (supplemental brief, page 11). Appellants further argue that it has not been shown as to why the skilled artisan would be confused by the claim language (id.).

The Examiner responds by asserting that, without proper antecedent basis, the scope of the claim cannot be ascertained since the phrase "method acts undertaken by the logic" refers to method steps or operations that do not exist in base claim 1 (answer, page 20).

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), citing In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Upon a careful review of the language of claim 30, we find that the claimed "method acts undertaken by the logic" does not clearly refer to any specific part of the graphical user interface of its base claim. Claim 1 includes a user terminal and a personalized toolbar wherein various sources may correspond

to the icons, but no method acts are recited. Although, the claim includes some functional language related to configuring the icons and causing the data to be presented on a monitor, it cannot be determined with sufficient certainty what is meant by "the logic" and which method acts claim 30 is referring to. Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). Here, the improper antecedent basis of the claimed terms in claim 30 prevents us from defining the scope of the claim with the level of precision and certainty required by our reviewing court.² Accordingly, we will sustain the rejection of claim 30 under the second paragraph of 35 U.S.C. § 112.

Turning now to the 35 U.S.C. § 103 rejection of claims 1, 2 and 30, we observe that the Examiner relies on Brown for teaching a method for customizing a toolbar for configuring a set of icons to cause data from their corresponding sources be displayed on

² It is not clear to us why Appellants have not amended the claim to correct the antecedent problem as Appellants refer to the disputed phrase as "insubstantial" (supplemental brief, page 11).

the user's monitor (answer, pages 3 & 4). The Examiner further relies on Brown for the user interface, on Kikinis for wireless communications between the user's terminal and a network (answer, page 4), on Namma for teaching an icon linked to a feed from a video camera and on Humpleman for showing the link to an in-home appliance (answer, page 5). Additionally, the Examiner points to column 2, lines 9-14 of Brown for a teaching of how toolbars may be modified by adding or deleting buttons or by changing the functions associated with a button (answer, page 15). Thus, the Examiner relies on Brown for providing the motivation for combining the references and changing the commands associated with each terminal button according to the features disclosed by Kikinis, Namma and Humpleman.

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Here, we find the Examiner's reliance on the teachings of Brown, Kikinis, Namma and Humpleman to be reasonable and sufficient to support a prima facie case of obviousness which shifts the burden to Appellants. However, in response to the prima facie case

obviousness presented by the Examiner, Appellants have failed to offer any convincing arguments to show any error in the Examiner's position. Additionally, arguments not made are waived. See 37 CFR § 41.37(c)(1)(vii).

Appellants argue that while Kikinis is used for teaching a wireless point-to-point communication system, Brown allows tailoring the toolbar only for accessing public content (suppl. brief, page 4). Appellants further assert that the proposed rejection lacks a showing of a positive suggestion for such prior art combination (suppl. brief, page 5) since Namma and Humpleman do not suggest the combination for the reason of security and convenience (suppl. brief, page 6). Appellants' arguments apparently redirect us back to Brown and how private and user-specific content is not considered in the reference (id.).

The Examiner refers to column 1, lines 49-54 of Brown describing the benefits of using toolbars as one-click shortcuts to their corresponding commands (answer, page 14) while their functions may be customized by changing those commands (answer, page 15). These modifications to the functions associated with a button, as taught by Namma and Humpleman, include modifications to the source and content of the data feed for accessing private

as well as public content. As stated above, the Examiner properly combines the teachings identifying other sources available to one of ordinary skill in the art with Brown, which actually provides for flexibility in customizing the toolbar buttons by selecting from the sources suggested by these other references.

A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine

prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). However, the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Although Brown uses public content as the data associated with the toolbar buttons, one of ordinary skill in the art would have looked into other sources of data such as those taught in Namma and Humpleman. The icon associated with the live video feed from a dwelling in Namma provides access to the content fed through the server from a camera (col. 23, lines 29-36) which suggests such types of private content for control and observation of the dwelling. Humpleman, similarly suggests other sources for providing private content to the user by associating the link to a consumer appliance (col. 18, ,lines 1-5). Thus, the Examiner has pointed to sufficient teaching and suggestion in the references to show that one of ordinary skill in the art would have been led to look into other sources of data for

providing access to these sources through their association with customized toolbar buttons. In this case the reason for the modification comes not only from the benefits of modifying the functions associated with each toolbar button of Brown, but from the fact that the use of video feeds from a dwelling or home appliance is taught by Namma and Humpleman as useful data sources associated with customized icons such as those of Brown. In fact, as discussed above, all the references recognize the benefits of using such icons in a personalized toolbar to have access to data sources specifically selected by the user.

With respect to claim 30, The Examiner properly provided supporting evidence for taking of Official Notice by relying on Charles Schwab web site (captured in 1997) presenting a list of services as the link to the site is manipulated (answer, page 5). The Examiner further argues that this page is a typical page that is accessed when the "Money" button in Figure 2a of Brown is manipulated (answer, page 16). We find that Appellants have not identified any clear flaw in the reasoning of the Examiner, nor have they pointed to any evidence of record indicating that the findings of the Examiner are unsupportable. We also remain unpersuaded by Appellants' arguments (suppl. brief, page 7) that

the Examiner has ignored the limitation of claim 30 and in fact, find the Examiner's line of reasoning to be persuasive.

In view of the analysis above, we find the Examiner's reliance on the combination of Brown, Kikinis, Namma and Humpleman to be reasonable and sufficient to support a prima facie case of obviousness with respect to claims 1, 2 and 30. Accordingly, the 35 U.S.C. § 103 rejection of independent claim 1 as well as claims 2 and 30 is sustained.

With respect to claims 3 and 28, Appellants argue that neither the thumbnail images derived from the text contained in the web pages nor the icons containing text are necessarily present in Shuping (suppl. brief, page 8). The Examiner responds by asserting that although some web pages do not contain text, in those that do the thumbnail images must be derived from text contained within the web page data (answer, page 16). The Examiner further argues that since icons are small images displayed on a computer representing objects, the disclosed thumbnails relate to "icons that are 'established by text from the respective source'" (answer, page 17). Comparing the two arguments and reviewing the references (columns 5 and 6 of Shuping), leave us unconvinced by Appellants' arguments that the

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claimed limitations are absent in Shuping. Therefore we sustain the 35 U.S.C. § 103 rejection of claims 3 and 28.

Regarding claims 4-7, 10-15, 27, 29 and 31, Appellants merely repeat the same arguments stated above with respect to claim 1 and add that no further suggestion is found in Barnett, Gerba, Nielsen and Oran (suppl. brief, pages 8-11). The Examiner responds to each argument by pointing to the specific portions of each of these references that suggest the modifications proposed in the rejection (answer, pages 17-20). Since Appellants have not identified any clear flaw in the reasoning of the examiner, nor have they pointed to any evidence of record indicating that the findings of the Examiner are unsupportable, we find the Examiner's reliance on the combination of the references to be reasonable and sufficient to support a prima facie case of obviousness. Therefore we sustain the 35 U.S.C. § 103 rejection of claim 4 over Brown, Kikinis, Namma, Humpleman and Barnett, of claims 5-7, 10, 12-15, 27 and 31 over Brown, Kikinis, Namma, Humpleman and Gerba, of claim 11 over Brown, Kikinis, Namma, Humpleman, Gerba and Barnett and of claim 29 over Brown, Kikinis, Namma, Humpleman, Gerba, Nielsen and Oran.

With respect to claims 8 and 16, we also remain unconvinced by Appellants' argument that changing something is different from generating an alert (suppl. brief, page 9) since the claims merely require that an alert signal be received and generated which, in turn, alters the icon. As pointed out by the Examiner (answer, page 18), as long as the icon on Nielsen is visually modified with a plurality of lines and catches the attention of the user, the reference suggests the claimed alert signal which alters the icon. Thus the 35 U.S.C. § 103 rejection of claims 8 and 16 over Brown, Kikinis, Namma, Humpleman, Gerba and Nielsen is sustained.

Finally, turning to the rejection of claim 9, Appellants assert that Anderson, as relied on by the Examiner for teaching enlarged icons, only does so for editing of the icon (suppl. brief, page 10). Again, weighing the opposing arguments, we find ourselves unpersuaded by Appellants' position that the combination is flawed because enlarging icons for editing is different from enlarging them for giving a more detailed view of the icon data to the user (id.). We note that the claim merely requires enlarging the icon which, as asserted by the Examiner (answer, page 19), is taught by Anderson which also provides to

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the user a more detailed view of the icon for editing purposes.
Therefore, we sustain the 35 U.S.C. § 103 rejection of claim 9
over Brown, Kikinis, Namma, Humpleman, Gerba and Anderson.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-16 and 27-31 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

MAHSHID D. SAADAT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ALLEN R. MACDONALD)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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